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10/039,892

10/26/2001

Howard E. Preissman

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EXAMINER

PHILOGENE, PEDRO

ART UNIT

PAPER NUMBER

3733

NOTIFICATION DATE

DELIVERY MODE

05/29/2007

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

intel\_prop@arthrocare.com

## Office Action Summary

**Application No.**

10/039,892

**Applicant(s)**

PREISSMAN, HOWARD E.

**Examiner**

Pedro Philogene

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 19 March 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-4, 15-18, 40-42, 52-54, 63-67 and 69-71 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4, 15-18, 40-42, 52-54, 63-67 and 69-71 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 3/19/07.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application
- ☐ Other: \_\_\_\_\_

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-4,15-18, 40-42,52-54,63-67,69-71 are rejected under 35 U.S.C. 102(b) as being anticipated by Baum (4,929,238):

With respect to the above claims Baum discloses a high pressure applicator for driving the delivery of a flowable tissue implant material, comprising a first column (12) having inner wall, an outer wall, a first end and second end having an orifice for delivering implant material therethrough, and an intermediate section, as best seen in figs.5,6, between the first and second end, the first column further comprising an introduction section (16) commencing at the first end and adapted to hold the implant material, the introduction section having a different size than the intermediate section; as best seen in FIGS.1-2,5-6, a second column (34), the second column being drivable with respect to the first column to generate a pressure within the first column; and a handle (42) integrally attached to the second column, the introduction section is sized to facilitate purging of air trapped in the implant material; at least one O-ring (40,54) mounted to an end portion of the second column (12) and interfacing with the inner wall of the second column (12); wherein the second column comprises a wall which is drivably engageable with one of the inner and outer walls; threading (56) on at least a portion of the inner wall of the first column, wherein the wall of the second column (34)

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is an external wall comprising threading engageable with the threading (9) on at least a portion of the inner wall, as set forth in column 8, lines 5-10, wherein the first column comprises a removable section (16) adapted to be removed from the first column for drivingly engaging the first and second columns.

As to claims 40-42, 67-71, the applicator of Baum is capable of generating such pressures, as claimed, since the structure of Baum is fully functionally identical to the applicator as claimed.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 20-23, 25-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Baum (4,929,238) in view of Perler (4,863,072).

With respect to the above claims, it is noted that Baum teaches all the limitations, Except for a threading covering only a portion of the second column and an end portion of the second portion relatively smooth and wherein the smooth end portion comprises a reduced diameter section having an outside diameter less than an inside diameter of the threads on the inner wall, and an enlarged section which closely fits with the substantially smooth inner wall to form pressure seal therewith; as claimed by applicant. However, in a similar art, Perler evidences the use of an applicator with such

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characteristics, as claimed by applicant, to allow the applicator to operate conveniently using one hand.

Therefore, given the teaching of Perler, it would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate those structures in the device of Baum, as taught by Perler to allow the applicator to operate conveniently using one hand.

Claims 19,68 are rejected under 35 U.S.C. 103(a) as being unpatentable over Baum (4,929,238) in view of Phillips (4,032,118).

With respect to claims 19, 68, it is noted that Eykman teaches all the limitations, except for the at least one sealing element comprises a Teflon Wrap, as claimed by applicant. However, in a similar art, Phillips teaches a sealing means with Teflon wrap to enhance the seal between two components.

Therefore, given the teaching of Phillips, it would have been obvious to one having ordinary skill in the art at the time the invention was made to apply the Teflon wrap of Phillips to enhance the seal between the first and the second columns.

### ***Response to Amendment***

Applicant's arguments filed 3/19/07 have been fully considered but they are not persuasive. First, applicant stated that Baum fails to teach a high pressure applicator for introducing tissue implant material. The examiner contends that the applicator of Baum is fully capable of introducing tissue implant material depending on the size of the tissue implant material. Second, applicant stated that the second end of injection device disclosed by Baum clearly does not include an introduction section. Baum does not

anticipate a first column in which an introduction section is provided at a first end and an orifice for delivering material therethrough is provided at the second end. Applicant stated in claim 54, "a first end and a second end having orifice for delivering implant material therethrough, and an intermediate section between said first and second ends, said first column further comprising an enlarged introduction section commencing at said first end, said introduction section having a larger diameter than the intermediate section;" As can clearly be seen in FIGS. 5,6, the first column has two ends and each of the ends having an orifice, either ends is capable of delivering implant material therethrough, and an intermediate section between said first and second ends, the first column further comprising an enlarged introduction section commencing at the first end (that is the enlarged section at 22) the introduction section having a larger diameter than the intermediate section (at least the outer diameter). Therefore, the reference to Braum clearly anticipates the invention of applicant, as claimed.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pedro Philogene whose telephone number is (571) 272-4716. The examiner can normally be reached on Monday to Friday 6:30 AM to 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo Robert can be reached on (571) 272 - 4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Pedro Philogene  
May 18, 2007

  
PEDRO PHILOGENE  
REGISTERED PATENT EXAMINER